

Transmittal Memorandum

TTAB

TO : Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

FROM : Martin E. Hsia, Esq.

DATE : January 11, 2006

RE : Serial No.: 78/493,473
Filed: October 1, 2004
Mark: "CABANA BEACH HOTEL & RESORT"
Opposer: Venture Out Properties LLC
Applicant: Estefan Enterprises, Inc.

We are sending you the following:

ORIG.	COPIES	DATED	DESCRIPTION
2		01/11/06	Notice of Opposition
1		01/11/06	Filing Fee (\$300.00)
1		01/11/06	Postcard receipt of Notice of Opposition and Filing Fee

- ☐ For your information
- ☐ For your files
- ☐ Per your request
- ☐ Per our conversation
- ☒ **For necessary action**
- ☐ Are returned herewith

- ☐ For signature and return
- ☐ For signature, forwarding,
as noted below & return
- ☐ For review & approval
- ☐ For distribution
- ☒ **For recording/filing**

REMARKS:



01-17-2006

U.S. Patent & TM Ofc/TM Mail Rcpt Dt. #72

C S

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**IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Application Serial No. 78/493,473
Filed on October 1, 2004
For the mark "CABANA BEACH HOTEL & RESORT"
Published in the Official Gazette on September 13, 2005

VENTURE OUT PROPERTIES LLC,)	
)	
Opposer,)	
)	Opposition No. _____
v.)	
)	
ESTEFAN ENTERPRISES, INC.,)	
)	
Applicant.)	
_____)	

NOTICE OF OPPOSITION

VENTURE OUT PROPERTIES LLC, a California limited liability company ("Opposer"), whose mailing address is 177 Post Street, Suite 910, San Francisco, California 94108, believes it will be damaged by the registration of the mark "CABANA BEACH HOTEL & RESORT" shown in Application Serial No. 78/493,473 covering "Hotel, resort hotels, restaurant, bar, cocktail lounge, provision of conference and banquet facilities" in International Class 43 (the "Application"), filed on October 1, 2004 in the name of ESTEFAN ENTERPRISES, INC., a Florida corporation located and doing business at 420 Jefferson Avenue, Miami Beach, Florida 33139 ("Applicant" or "Estefan Enterprises"), and hereby opposes the Application on the following grounds:

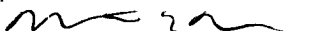
01/24/2006 6THOMAS2 00000047 78493473

01 FC:6402

300.00 OP

CERTIFICATION OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as U.S. first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, on January 11, 2006.



MARTIN E. HSIA, Reg. No. 32,471

1. Opposer is the owner and operator of a hotel located in Honolulu, Hawaii, and has provided various goods and services in connection with the hotel under the mark "CABANA" (the "Cabana Mark").

2. On or about May 5, 2005, Opposer was assigned all right, title and interest in and to the Cabana Mark, together with the goodwill of the business associated therewith and the right to sue for any past infringement, by Venture Out RV Centers, Inc. and The Cabana at Waikiki, LLC, which were entities related to Opposer that provided goods and services in connection with the hotel under the Cabana Mark since at least as early as May 1999.

3. Opposer and its predecessors have for many years advertised, sold, and provided hotel services under the Cabana Mark in the United States. Opposer has acquired and developed an exceedingly valuable goodwill with respect to its Cabana Mark.

4. By virtue of its efforts, including but not limited to the expenditure of considerable sums for advertising and promotional activities, and by virtue of the excellence of its hotel services, Opposer has gained for its Cabana Mark a most valuable reputation.

5. Opposer's Cabana Mark is famous under U.S.C. § 1125(c)(1).

6. Opposer's Cabana Mark is famous as to hotel services under U.S.C. § 1125(c)(1).

7. Since at least as early as May 1999, Opposer, through its predecessors in interest, has had extensive, exclusive, and continued use of the Cabana Mark.

8. On February 7, 2005, Opposer filed an application with the U.S. Patent and Trademark Office (the "Office"), to register the Cabana Mark for "hotel services" in International Class 43.

9. The subject Application Serial No. 78/493,473 was filed by Applicant on or about October 1, 2004, for the mark "CABANA BEACH HOTEL & RESORT" ("Applicant's Mark").

10. The Application of Estefan Enterprises covers "Hotel, resort hotels, restaurant, bar, cocktail lounge, provision of conference and banquet facilities" in International Class 43 ("Applicant's Services").

11. "Hotel, resort hotels, restaurant, bar, cocktail lounge, provision of conference and banquet facilities" are related to "hotel services".

12. The Application of Estefan Enterprises seeks registration of the mark "CABANA BEACH HOTEL & RESORT".

13. As indicated in the Application, Applicant has disclaimed any exclusive rights to use the portion of its mark consisting of "BEACH HOTEL & RESORT".

14. The portion of Applicant's Mark consisting of "BEACH HOTEL & RESORT" is descriptive of Applicant's Services.

15. The dominant portion of Applicant's Mark is "CABANA".

16. The dominant portion of Applicant's Mark is identical to Opposer's Cabana Mark.

17. Applicant's Mark so closely resembles Opposer's Cabana Mark, that if used in connection with the applied-for services, it would be likely to cause confusion, mistake and/or deception of the relevant trade and public, to the damage of Opposer.

18. The use and registration of Applicant's Mark, as indicated above, would result in confusion, mistake and/or deception as to the source or origin of Applicant's Services,

leading consumers to believe that they are somehow affiliated with, approved, sponsored, or licensed by Opposer.

19. A likelihood of confusion exists under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), between Opposer's Cabana Mark and Applicant's Mark, "CABANA BEACH HOTEL & RESORT".

20. If Applicant is permitted to use and register Applicant's Mark for Applicant's Services, as specified in the Application, confusion in trade, resulting in irreparable damage and injury to Opposer, inevitably would result by reason of the similarity between Applicant's and Opposer's marks and the services sold and provided thereunder. Any defect, objection, or fault found with services marketed under Applicant's Mark, "CABANA BEACH HOTEL & RESORT", would reflect on, and injure, the reputation Opposer has established for services sold under its Cabana Mark.

21. If Applicant is granted the registration herein opposed, Applicant would obtain a *prima facie* exclusive right to use the mark set forth in the Application. Such registration would become a source of damage and injury to Opposer through the generation of confusion, mistake and/or deception, the dilution of Opposer's mark, and the diminution of Opposer's ability to control the quality of services sold thereunder.

22. Moreover, such registration would run contrary to the requirement that all doubts as to the likelihood of confusion must be resolved in favor of Opposer, and against Applicant, who has a legal duty to select a mark totally dissimilar to marks already in use.

23. Use of Applicant's Mark in connection with the services listed in the Application, would be likely to dilute Opposer's Cabana Mark.

24. On information and belief, the services covered by the Application of Estefan Enterprises are or will be offered to the same class of purchasers and users who purchase and use the services in connection with which Opposer has used and is using its Cabana Mark.


25. There is no issue as to priority. As shown by Opposer's application Serial No. 76/630,391 identified above, Opposer has been using the Cabana Mark since at least as early as May 1999.

26. The Application of Estefan Enterprises was filed on October 1, 2004, on the basis of an intent-to-use Applicant's Mark and no Amendment to Allege Use has been filed by Applicant.

WHEREFORE, Opposer prays that this Opposition be sustained, that the Application be refused, and that the mark applied for therein be refused registration. A duplicate copy of this Notice of Opposition and the fee required in 37 C.F.R. § 2.6(a)(17) are enclosed.

DATED: Honolulu, Hawaii, January 11, 2006.

Respectfully submitted,



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